



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,574	04/02/2004	Daryl Hamilton	08049.0929	3806
7590 12/21/2010 Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 1300 I Street, NW Washington, DC 20005-3315				
EXAMINER AMSDOLL, DANA				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
12/21/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/817,574

Applicant(s)

HAMILTON, DARYL

Examiner

DANA AMSDELL

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (F-TO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for pre-appeal review, including the fee set forth was filed in this application after final rejection. Since this application is eligible for continued examination as determined by the panel review and the fee set forth has been timely paid, the finality of the previous Office action has been withdrawn. Applicant's submission filed on 10/27/2010 has been entered.

Response to Arguments

2. Applicant's arguments, see Reasons for Pre-Appeal Brief Request for Review, filed 10/27/2010, with respect to the rejection(s) of claim(s) 1-20 under 35 USC § 103(a) directed to the combination of Radican, Sansome, and Official Notice failing to render claim 1 limitations "obvious". Remarks have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made over Radican (US 6,148,291), herein "Radican"; in view of Whitehouse (US 5,319,562); herein "Whitehouse"; and further in view of "Official Notice".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 depend from Markush-type claims 5 and 11, wherein a specific option is undefined. However, claims 19 and 20 do depend from a specified option. This leaves the scope of the claims indefinite.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must hold claim to a non-abstract idea, such as a process that is (1) tied to a particular machine or (2) transforms underlying subject matter (such as an article or materials) to a different state. *Bilski v. Kappos*, 561 U.S. (2010); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978);

Gottschalk v. Benson, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim 1 is held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. §101. The rationale for this finding is as follows:

Applicant's method steps lack sufficient recitation of a machine. Involvement with a machine in claim 1, with steps is nominally, insignificantly, or tangentially related to the performance of the steps, (e.g. the steps of generating...; printing...; and receiving... fail to recite the performing apparatus). As claims 2-10 depend from the ineligible claim, and additionally fail to recite sufficient involvement with a particular machine, they are likewise ineligible to qualify as statutory under 35 U.S.C. §101.

Please note in the interest of subsequent prosecution, that the recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.* (Appeal 2008-1495).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radican (US 6,148,291), herein "Radican"; in view of Whitehouse (US 5,319,562), herein "Whitehouse"; and further in view of "Official Notice".

8. Regarding claims 1, 7 and 13 being to a method, system and computer readable medium (Radican - column 4, lines 37-43), directed to tracking a tray of items, Radican teaches an invention that "pertains generally to logistics methods and systems for tracking and control of containers, shipping racks and inventory. More particularly, the invention pertains to methods and systems which create and maintain an accurate record of the location and movement of containers, racks and inventory within the boundaries and between sites such as factories, assembly plants, warehouses, shipping yards and freight switching facilities" (column 1, lines 10-19). Radican additionally teaches:

- associating the tray with a container, the container having a container unique identifier (column 7, lines 50-54); and
- receiving a load container scan, the load container scan associating the *container unique identifier* with the racks, or trays, which fit inside the containers (column 7, lines 42-54; and column 9, lines 1-6).

While disclosing the key element of keeping a record which tracks, or monitors the 'racks' or "trays" type, status, and location (column 14, lines 28-36; and column 17,

lines 14-24), and while failing to disclose labels, Radican does teach 'hard copy reports... in any format' (Fig. 3; and column 8, lines 38-48), Radican fails to be specific to generating an enhanced label comprising a routing code and a label unique identifier, the enhanced label comprising a routing code, the enhanced label being printed

Whitehouse does disclose specifically:

- the generation of an enhanced label comprising a routing code and a label unique identifier (Abstract – 'The end user computers preferably include a printer and a postage printing program for directing the printer to print addresses and postage on envelopes and labels. The postage printing program assigns a unique serial number to every printed envelope and label, where the unique serial number includes a meter identifier unique to that end user. As a result, every printed envelope and label contains a unique serial number'; and
- the enhanced label being printable and affix able (Fig. 6; and column 12, lines 25-27).

One of ordinary skill in the art at the time of invention would find it obvious to modify the teachings of Radican by the Whitehouse's disclosure of mail label printing, as they overlap in providing a technology directed to the solution to problematic logistics with the versatility, space-saving, and cost-effective use of a personal computer and printer.

Neither Radican or Whitehouse teach specifically to the enhanced label being unique within a predetermined time period" so that additional labels generated within the

predetermined time period are distinguishable from the enhanced label. However, Official Notice is taken in the use of a serialization management as disclosed in the Applicant's specification (§72), involves a finite number of unique combinations which can be equated to a timeframe, is old, well-known, and performed easily on a PC with common commercial software, so that it would be used in industries producing/processing a high volume of items that are processed within a specific timeframe, such as a postal service. Therefore, it would have been obvious to one of ordinary skill in the art that in the interests of conserving computer processing energy and printing resources, to set the number of unique combinations of variables, or serialization, which in this case is bar-coded indicia, to the required known delivery rate thus identifying it as unique within a timeframe from other labels.

9. Regarding claims 2, 3, 8, 9, 14 and 15, Radican and Whitehouse, in view of Official Notice, teach the claim dependencies, and Radican further teaches receiving a load vehicle scan, the load vehicle scan associating the container unique identifier with a vehicle identifier and a load and unload time (Fig., elm. V, Fig. 3- association between 'Status' and 'Time', and column 8, lines 45-55).

10. Regarding claims 4, 10, and 16, Radican, and Whitehouse, in view of Official Notice teach the claim dependencies, and Radican further teaches receiving an unload container scan, the unload container scan associating the container unique identifier with an unload container time (Fig. I, elm. C; and column 4, lines 60-67).

9. Regarding claims 5, 11, 17, 19 and 20, Radican and Whitehouse, in view of Official Notice teach the claim dependencies, and Whitehouse further teaches wherein the label unique identifier comprises at least one of a machine identifier, a label source, a holdout identifier, a serial number, and a label type (Abstract – ‘label contains a unique serial number’).; wherein the label type (Fig. 5, elm. 4) contains a constant field (elm. 4c-‘ us postage’, a key field (4e –‘unique meter identification number’), and a variable field (4f –‘optional barcode representation of postage’).

10. Regarding claim 6, 12 and 18, Radican and Whitehouse, in view of Official Notice teach the claim dependencies, and Whitehouse further teaches wherein the routing code comprises at least one of a destination code, a content identifier number, a DOD code, and an MPC code (Abstract – ‘The end user computers preferably include a printer and a postage printing program for directing the printer to print addresses and postage on envelopes and labels wherein the address includes a zip/destination code).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANA AMSDELL whose telephone number is (571)270-5210. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. A./
Examiner, Art Unit 3627

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627